

REMARKS

This Amendment and Request for Reconsideration is submitted in response to an outstanding Office Action dated August 21, 2005, the shortened statutory period for response set to expire on November 21, 2005. Accordingly, no extension of time is believed due. In the event that the Commissioner determines that an extension of time is due, the undersigned hereby petitions for such extension and authorizes the Commissioner to charge any required fee to the Milbank Deposit account 13-3250. Applicants submit this Amendment and Request for Reconsideration further to an interview conducted with the Examiner on November 10, 2005. Applicants wish to give sincere thanks and appreciation to the Examiner for his time and effort in conducting this interview.

I. Status of the Claims

Please amend independent claims 1, 12, 17 and 18 as indicated above. Claim 7 was previously cancelled.

The limitation, “with said blade having a rounded profile on a first and second end” is demonstrated in FIG. 1 and FIG. 2. Both figures show tongue depressors with a rounded profile on each end. The tongue depressor is described as a standard “shape” for use with a self-illuminating tongue depressor handle attachment at page 5 of the specification at lines 6-10. The limitation of the tongue depressor to a “non-infant, youthful patient’s standard size” is supported on page 4 of the specification at lines 17-20, which discusses the “empowerment of the young patient as well as the interactivity between patient and doctor.” The limitation of “any portion of said tongue depressor blade may be received within said mouth of said patient during said examination” was previously disclosed in the existing claims.

Claims 1-6 and 8-20 are now pending in the application. Claims 1, 12, 17 and 18

are independent claims.

Applicants acknowledge the Examiner's citation of statutory authority as a basis for claim rejections.

II. Rejections under 35 U.S.C. § 102

The Examiner has rejected claims 12, 17 and 18 under 35 U.S.C. § 102 as being anticipated by Esker et al., or Daly et al.

Amended claim 12 requires: an apparatus for motivating the cooperation of youthful patients in oral examinations, comprising a non-infant, youthful patient's standard size and shape tongue depressor for use with a self-illuminating tongue depressor handle attachment for restraining a tongue of a patient to allow clearer examination of a rear of a patient's mouth and throat, comprising a blade having two elongated, substantially flat surfaces for restraining said tongue of said patient, at least one of said two surfaces bearing an ornamental image along at least a portion thereof intended to be inserted into said patient's mouth, with said blade having a rounded profile on a first and second end, said ornamental image being made from non-toxic ink, and any portion of said tongue depressor blade may be received within said mouth of said patient during said examination, even if said any portion of said tongue depressor has said ornamental image appearing therealong.

Esker et al. discloses a handle for a food product. There is no disclosure or suggestion in Esker of a "non-infant, youthful patient's standard size and shape tongue depressor for use with a self-illuminating tongue depressor handle attachment." At best, Esker may disclose a device which could be used as an infant tongue depressor. The above claims have been amended to include the limitation to "non-infant youthful patients." This limitation precludes the device described in Esker from disclosing the tongue depressor as described in

claim 12. Esker is not a standard size and shape tongue depressor for non-infant youthful patients as identified in the attachments to the October 7, 2004 Declaration of Dr. Mehrotra.

Similarly, in Daly et al., there is no disclosure or suggestion of a “non-infant, youthful patient’s standard size and shape tongue depressor for use with a self-illuminating tongue depressor handle attachment.” Daly et al. discloses a forked like device which is not in the standard size and shape of a tongue depressor and further does not have a rounded profile on both ends. Moreover, if Daly et al. were to be implemented as a tongue depressor, the fork-like portion would be unsuitable for examining a youthful patient which precludes Daly from meeting the limitation of “any portion of said tongue depressor blade may be received within said mouth of said patient during said examination.” Accordingly, applicants respectfully ask the Examiner to withdraw the rejection of claim 12 under 35 U.S.C. § 102 over Esker et al. or Daly et al.

Claims 17 and 18 include a similar limitation, which is not disclosed or suggested by either Esker et al. or Daly et al. Accordingly, applicants ask the Examiner to withdraw the rejection of claims 17 and 18 under 35 U.S.C. § 102 over Esker et al. or Daly et al.

III. Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 1-6, 9, 11 and 13-16 under 35 U.S.C. § 103(a) as being unpatentable over Esker et al. The Examiner states that Esker discloses all of the claimed limitations except a device having the specific size claimed. The Examiner states that it would have been obvious to provide the device of Esker in any of numerous sizes, since a mere change in the size of a component is generally recognized as being within the level of ordinary skill in the art.

Amended claim 1 requires a tongue depressor for receipt within a mouth of a patient during an examination, comprising a blade comprising first and second sides separated by

a thickness of said blade, said blade further comprising first and second tongue contact portions located along said first and second sides, respectively with said blade having a rounded profile on a first and second end; and an ornamental image appearing along at least a portion of at least said first tongue contact portion of said first side; wherein said tongue depressor is a non-infant, youthful patient's standard size and shape for use with a self-illuminating tongue depressor handle attachment, said tongue depressor is not coated with flavor, and any portion of said tongue depressor blade may be received within said mouth of said patient during said examination, even if said any portion of said tongue depressor has said ornamental image appearing therealong.

The Declaration of Dr. Mehrotra, submitted October 11, 2004, identifies standard sizes for tongue depressors. In particular, Adults (regular/Reg), Seniors (Standard/Std.), and children (Junior/Jr.). The attachments to Dr. Mehrotra's Declaration list the respective sizes of the regular as 6" x 3/4"; standard as 6" x 11/16"; and junior as 5 1/2" x 5/8". Although not listed in the declaration or on the attachments, the size of an infant depressor is 4 1/2" x 3/8". Other than the infant depressor, these standard size tongue depressors (*i.e.*, standard, regular and junior) fit in the self-illuminating tongue depressor handle attachment and are held firmly. In contrast, a smaller size blade, such as a popsicle stick or infant size depressor is not held firmly in the self-illuminating tongue depressor handle attachment. In fact, when a blade the size of an infant depressor or popsicle stick is placed in a self-illuminating tongue depressor handle attachment the blade can pivot or swing from side to side. This is entirely unsatisfactory and could lead to potential injury of a patient because the blade is not controlled.

Applicants submit that a non-infant, youthful patient's standard size and shape tongue depressor for use with a self-illuminating tongue depressor handle attachment is not "any

of numerous sizes” but is one of a particular and known set of sizes, (*i.e.*, regular, standard, or junior). The standard size and shape are significant both for using the tongue depressor with a self-illuminating handle attachment and also for conducting a patient examination. There is no teaching or suggestion in Esker for making the disclosed handle for a food product in the standard size and shape of a tongue depressor and thus it would not be obvious to do so.

The Examiner has rejected claims 1-6 and 8-16 under 35 U.S.C. § 103 as being unpatentable over Daly et al. As with Esker, the Examiner states that Daly discloses all of the limitations except the specific size claimed by applicant. In light of the amendments specifying the size and shape of the tongue depressor, and for the same reasons provided above with respect to Esker et al., Applicants submit that Daly et al. does not teach or suggest all of the limitations of independent claims 1, and 12. Further, a tongue depressor and fork are not analogous art as defined under MPEP 2141.01(a). An inventor would not consider a device with sharp fork like tines when considering the problem of reducing a child’s fear and trauma during an oral exam.

The Examiner has rejected claims 1-6 and 8-16 under 35 U.S.C. § 103 as being unpatentable over Chen et al. in view of Esker et al. The Examiner acknowledges that Esker does not disclose the particular size, and relies on Chen to disclose a tongue depressor. The Examiner also admits that Chen does not disclose providing an ornamental image. The Examiner states that the combination would “make the device attractive and entertaining and to make the device more valuable to the user.” Except from the teachings of applicant’s own disclosure, which is not admitted prior art, the Examiner has not identified any particular motivation to combine these two particular references. Further, a tongue depressor and food product handle are not analogous art as described under MPEP 2141.01(a). “In order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the

field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). The inventor, in this case, was concerned with obtaining the cooperation of a patient during examination and not with serving food. While the two items have a similar shape, there are clear structural differences. Specifically a tongue depressor has a wider, longer, and flatter shape. An inventor further would not logically have considered a food product handle when considering the problem of reducing a child's fear and trauma during an oral exam because such food product handles are not to the inventor's knowledge used for giving oral exams to children and usually come with food placed on them.

During the Interview of November 10, 2005, the Examiner expressed a belief that it may be obvious to place an ornamental image on a tongue depressor, in view of Chen et al. even without combining Chen et al. with Esker et al. The Applicants submit that although a person of ordinary skill could have placed an ornamental image on a tongue depressor as disclosed in Chen et al., there is still no suggestion or motivation to do so in the reference or otherwise. While Applicants can appreciate that it may be obvious to paint a decoration on an item for the purpose of making it more attractive or entertaining, this is not necessarily true of all items. In particular, medical devices found in a doctor's office are not normally decorated with appealing ornamental designs. Applicants submit that the rejections based on Esker et al., Daly et al. and Chen et al. either individually or in combination are not supported, and ask that the rejections be withdrawn. Should the Examiner still find a *prima facie* case of obviousness in light of the above remarks, Applicants submit evidence of secondary considerations in the following forms:

Commercial Success as described at MPEP 716.03

See attached declaration of Catherine Drogin and attached exhibits.

Applicants submit that the demonstrated results over the past 13 months provide strong evidence that it was not obvious to place an ornamental image on a tongue depressor.

Unexpected Results as described at MPEP 716.02

See attached declaration of Dr. Lewis Kass.

Applicants submit that the closest prior art, Esker et al., which discloses a decorative design on a frozen confection handle may have the expected result of being appealing to children, but will not have the unexpected results of breaking down doctor/patient barriers by allowing a doctor to learn something personal about his or her patients, reducing anxiety of young patients by distracting them during an oral examination, giving young patients a sense of control, and reducing the total examination time by gaining patient cooperation.

VI. Request for Reconsideration

Applicants respectfully submit that the claims of this application are in condition for allowance. Accordingly, reconsideration of the rejection and allowance is requested. If a conference would assist in placing this application in better condition for allowance, the undersigned would appreciate a telephone call at the number indicated.

Respectfully submitted,
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